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In re Application of SHI et al.

Application No.: 09/763,163

PCT No.: PCT/JP00/03874

Int. Filing: 15 June 2000

Priority Date: 24 June 1999

Attorney Docket No.: L9289.01113PCT

For: WIRELESS COMMUNICATION  
APPARATUS AND WIRELESS  
COMMUNICATION METHOD

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: DECISION ON PETITION  
: UNDER 37 CFR 1.47(a)  
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This is a decision on applicant's renewed petition under 37 CFR 1.47(a) filed in the United States Patent and Trademark Office (USPTO) on 26 October 2001.

### **BACKGROUND**

On 29 March 2001, applicants, in response to 20 March 2001 Notification of Missing Requirements, filed a petition in an attempt to satisfy the requirements of 35 U.S.C. 371(c)(4). The petition requested the acceptance of the application without the signature of inventor Guizeng Shi. The petition included the requisite petition fee, a declaration of Osamu Kato regarding Mr. Shi's refusal to sign, and a declaration signed by the 37 CFR 1.47(a) applicants, Osamu Kato and Mitsuru Uesugi, on behalf of nonsigning inventor Guizeng Shi.

On 31 August 2001, a decision dismissing applicants' petition was mailed indicating that applicants had not demonstrated Mr. Shi's refusal to sign the application.

On 26 October 2001, applicants filed a renewed petition under 37 CFR 1.47(a)

### **DISCUSSION**

A petition under 37 CFR §1.47(a) must be accompanied by (1) the fee under 37 CFR §1.17(h), (2) factual proof that the non-signing joint inventor(s) refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the non-

signing inventor(s), and (4) an oath or declaration by each available joint inventor on his or her own behalf and on behalf of the non-signing joint inventor(s).

Items (1), (3) and (4) have been submitted and satisfy the requirements of 37 CFR 1.47(a). With respect to item (2), the petitioner's inability to find or reach a nonsigning inventor after diligent effort, Section 409.03(d) of the Manual of Patent Examining Procedure (MPEP), Proof of Unavailability or Refusal, states, in pertinent part:

Where inability to find or reach a nonsigning inventor "after diligent effort" is the reason for filing under 37 CFR 1.47, a statement of facts should be submitted that fully describes the exact facts which are relied on to establish that a diligent effort was made.

The fact that a nonsigning inventor is on vacation or out of town and is therefore temporarily unavailable to sign the declaration is not an acceptable reason for filing under 37 CFR 1.47.

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The statement of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. Copies of documentary evidence such as internet searches, certified mail return receipts, cover letters of instructions, telegrams, that support a finding that the nonsigning inventor could not be found or reached should be made part of the statement. The steps taken to locate the whereabouts of the nonsigning inventor should be included statement of facts. It is important that the statement contain facts as opposed to conclusions.

Here, petitioner has provided evidence with a statement of facts signed by joint inventor Osamu Kato, having firsthand knowledge of the facts recited therein. In his statement, Mr. Kato indicated that he attempted to contact Mr. Shi by registered mail on 16 February 2001. The mailing was returned to Mr. Kato "after one week custodial period due to the absence of the recipient". On 11 September 2001, Mr. Kato states that he attempted to telephone Mr. Shi and found that "his last known telephone number is no longer being used". About the same time, Mr. Kato attempted to reach Mr. Shi by e-mail, to no avail.

Thereafter, Mr. Kato made an inquiry with the Japanese post office "as to whether Mr. Shi had left a Request for Forwarding and was informed that he had not". On 11 October 2001, Ms. Tomoko Najima of Matsushita Electric Industrial Company, Ltd. wrote to Mr. Kato enclosing a declaration and specification for this application (including claims, abstract and drawings) for his signature. A copy of the Japanese postal service's Record of Delivery (with English translation) accompanied Mr. Kato's statement, which indicates that "This mail could not be delivered since a forwarding address of recipient is uncertain". The actions taken by petitioner are sufficient to prove that "a diligent effort" was made to contact the nonsigning inventor.

In sum, the evidence submitted supports a finding that the nonsigning inventor could not be found or reached after diligent effort for the reasons set forth above. Accordingly, it is appropriate to accord the national stage application status under 37 CFR §1.47(a) at this time.

### CONCLUSION

The petition under 37 CFR §1.47(a) is GRANTED.

The U.S. Designated/Elected Office is authorized to accept the application as a 37 CFR 1.47(a) application using the declaration filed 29 March 2001 and to mail a filing receipt. The application has an international filing date of 15 June 2000 under 35 U.S.C. 363, and a date of 29 March 2001 under 35 U.S.C. 371(c).

As provided in 37 CFR 1.47(a), a notice of the filing of this application will be forwarded to the non-signing inventor at his last known address of record. Also, a notice of the filing of this application will be published in the Official Gazette.

The application is being returned to the International Division for processing as the U.S. National Stage of the above-identified international application.



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